



TRANSMITTAL OF APPEAL BRIEF

Docket No.

61135/P012US/10105074

In re Application of: Salim G. Kara, et al.

Application No.

08/953,477

Filing Date

October 17, 1997

Examiner

J. Pokrzywa

Group Art Unit

2622

Invention: POSTAGE SERVER SYSTEM AND METHOD

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: June 12, 2001.

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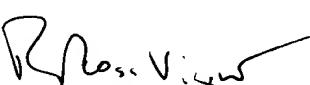
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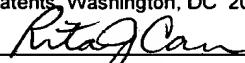
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Dated: August 13, 2001

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Application Number	08/953,477	RECEIVED
Filing Date	October 17, 1997	AUG 20 2001
First Named Inventor	Salim G. Kara	Technology Center 2600
Examiner Name	J. Pokrzewski	
Group Art Unit	2622	
Attorney Docket No.	61135-P012US-10105074	

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FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code	Fee Code (\$)	Fee Code (\$)	Fee Code (\$)
105	130	205	65
127	50	227	25
139	130	139	130
147	2,520	147	2,520
112	920*	112	920*
113	1,840*	113	1,840*
115	110	215	55
116	390	216	195
117	890	217	445
118	1,390	218	695
128	1,890	228	945
119	310	219	155
120	310	220	155
121	270	221	135
138	1,510	138	1,510
140	110	240	55
141	1,240	241	620
142	1,240	242	620
143	440	243	220
144	600	244	300
122	130	122	130
123	50	123	50
126	180	126	180
581	40	581	40
146	710	246	355
149	710	249	355
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AUG 20 2001

Technology Center 2600



In re Application of:

Salim G. Kara, et. al.

Serial No.:

08/953,477

Filed:

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Art Unit:

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Examiner:

J. Pokrzywa

For:

POSTAGE SERVER SYSTEM AND METHOD

BOX: AF
 Commissioner for Patents
 Washington D.C. 20231

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Date Deposited: August 13, 2001

Signature: Rita J. Carr

Printed Name: Rita J. Carr

ATTENTION: Board of Patent Appeals and Interferences**APPELLANT'S BRIEF**

This brief is in furtherance of the Notice of Appeal filed in this case on June 12, 2001.

The fees required under § 1.17(c) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying Transmittal of Appeal Brief.

This Brief is filed in triplicate.

This Brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Invention
- VI. Issues

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VII. Grouping of Claims**VIII. Arguments****Appendix A. Claims on Appeal****I. Real Party In Interest**

The real party in interest in this appeal is Stamps.com Inc., a Delaware corporation having a place of business located at 3420 Ocean Park Boulevard, Suite 1040, Santa Monica, California.

II. Related Appeals and Interferences

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. Status of Claims

A. Total Number of Claims: 19

B. Status of All Claims:

1. Claims canceled: 1-56 and 75-89
2. Claims withdrawn: None
3. Claims pending: 57-74 and 90
4. Claims allowed: None
5. Claims rejected: 57-74 and 90

C. Claims on Appeal: 57-74 and 90

IV. Status of Amendments

All previously filed amendments have been entered and acted upon by the Examiner. Accordingly, the claims on appeal include those amendments indicated in the Amendment filed November 20, 2000.

V. Summary of Invention

The invention involves transmission of information from a sending location (110, 111, and 112 Fig. 1) to a recipient location (140 and 141 Fig. 1) through a way location (101 Fig. 1). (Page 13, lines 2-6). A user may invoke a system, such as a FAX (101 Fig. 1) or computer (111 Fig. 1) to electronically transmit a document including the information (130 Fig. 1) from the sending location. (Page 13, lines 7-11). The sending user may also transmit the document by physical means, such as posting a letter (112 Fig. 1). (Page 13, lines 14-15).

The way location includes document receiving (320 and 302 Fig. 3) and reproduction (301 Fig. 3) facilities. (Page 13, lines 10-11). The way location may be selected according to its proximity to the intended recipient location, such as may be determined automatically through reference to a recipient's address information. (Page 32, lines 15-20). Alternatively, the way location may be selected according to proximity to the sender's location. (Page 32, lines 22-25). The way location may be operable with corresponding intermediate document transmission circuitry disposed at other locations, such as throughout a postal system. (Page 20, lines 1-22).

The document receiving facilities of the way location include a converter circuit (302 Fig. 3) which converts received physical document into an electronic representation. (Page 13, lines 15-19). The way location converter circuit may also include circuitry adapted to accept electronic documents communicated utilizing different protocols. (Page 9, lines 2-11, and page 13, lines 7-13). The converter circuitry may further be adapted to determine delivery address information from the transmitted document, such as for delivery of the document and/or to verify the accuracy of the delivery address information. (Page 23, lines 23-26, and page 24, line 21, through page 25, line 4).

The reproduction facilities of the way location include the ability to physically reproduce the document. (Page 16, lines 1-2). The reproduction facilities provide for the inclusion of a stamp, or other indication of payment or authorization for subsequent delivery of the document, which may be physically reproduced with the document. (Page 14, lines 24-25, and page 39, lines 17-21). The reproduction facilities may further provide for preparing a suitable container for the actual document or may properly format the document for electronic transmission. (Page 14, lines 15-20, and page 39, lines 17-21).

The way location may further include acknowledgement circuitry to provide an acknowledgement of receipt of a transmitted document. (Page 38, lines 1-3). The acknowledgement of receipt may be withheld if a suitable means for funding the transmission of the document is not also included. (Page 36, lines 25-27).

The invention may further include the transmission of ancillary information for use by the receiving facilities along with the transmission of a document. (Page 25, lines 15, through page 26, line 17). For example, ancillary information transmitted with a document may include information with respect to transmission date or time, recipient's address, or special handling instructions. (Page 25, lines 17-25). Additionally or alternatively, ancillary information transmitted with the document may include the aforementioned information with respect to funding the delivery of the document. (Page 26, lines 3-8).

Information with respect to funding the delivery of the document may be in the form of a value data packet, such as an electronic or digital stamp indicia. (Page 27, lines 13-17). This value data packet may be created by a secure memory device coupled to the sending station. (Page 27, lines 1-10). Such a secure memory may be utilized to provide other trustworthy data, such as the aforementioned date and time information included with the document transmission. (Page 21, lines 5-11).

VI. Issues

The outstanding issues in the final Office Action dated September 13, 2000 ("the Office Action") are:

(1) Claims 57-66, 70-74, and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal*, patent number 5,826,034 (hereinafter *Albal*), in view of *Kunigami*, patent number 5,508,817 (hereinafter *Kunigami*), and further in view of *Berkowitz et al.*, patent number 5,903,877 (hereinafter *Berkowitz*); and

(2) Claims 67-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal* in view of *Kunigami*, further in view of *Berkowitz*, and further in view of *Maxwell*, patent number 5,805,810 (hereinafter *Maxwell*).

VII. Grouping of Claims

For the purposes of this Appeal Brief only, the claims have been grouped as follows:

Group I	57-67, 70, 71, 73, 74, and 90
Group II	68
Group III	69
Group IV	72

VIII. Arguments

Claims 57-66, 70-74, and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal*, in view of *Kunigami*, and further in view of *Berkowitz*. Claims 67-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal* in view of *Kunigami*, further in view of *Berkowitz*, and further in view of *Maxwell*.

GROUP I – CLAIMS 57-67, 70, 71, 73, 74, AND 90

The Examiner Has Relied Upon Hindsight In Rejecting The Claims

As an initial matter, Appellants point out, although a prior art reference may be relied upon for that which it teaches or suggests to one of ordinary skill in the art, M.P.E.P. § 2123, that which is taught or suggested by a prior art reference must be determined without benefit of hindsight gleaned from Appellants' disclosure, M.P.E.P. § 2145(X)(A). It is respectfully asserted that the Examiner, in rejecting the pending claims, has clearly relied upon Appellants' disclosure to arrive at an interpretation of the prior art to meet the claims.

For example, in responding to Appellants' arguments with respect to patentability of independent claim 57, the Examiner expressly states that "*Kunigami* can be interpreted as producing 'an indicia of payment authorizing delivery of said human readable information to said selected location', as required by the claim," Final Office Action at page 3, lines 10-11. However, the question is not whether *Kunigami* can be interpreted to meet the claim, but rather whether the claim limitation was reasonably suggested by the disclosure of *Kunigami* to one having ordinary skill in the art at the time the invention was made, M.P.E.P. § 2124.

Accordingly, it is asserted that the rejections of record with respect to claim 57, and the claims dependent therefrom, are improper. Appellants respectfully request that the rejections of record, based upon unpermissible hindsight, be withdrawn.

The Examiner Has Not Established A Prima Facie Case Of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Appellants respectfully assert that the references lack proper motivation to combine in addition to lacking all the claim limitations.

The Prior Art Combination Does Not Meet All Claim Elements

The independent claim, claim 57, recites:

an intermediate station [including] a reproducing circuit adapted to reproduce said information in human readable form, wherein said reproducing circuit also produces an indicia of payment authorizing delivery of said human readable information to said selected location.

The Examiner concedes that the primary reference *Albal* does not teach a reproducing circuit producing an indicia of payment authorizing delivery of the human readable information to the select location. However, the Examiner opines that the secondary reference *Kunigami* teaches a system which delivers information to a selected location from a transmitting location, wherein an intermediate station comprises a reproducing circuit which produces an indicia of payment authorizing delivery of the human readable information to the second location.

Appellants respectfully assert that *Kunigami* does not teach or suggest an intermediate location comprising a reproducing circuit adapted to reproduce either information or an indicia of payment in human readable form. Instead, *Kunigami* expressly teaches both reception and delivery of the messages in electronic form, see column 1, lines 42-46.

In response to Appellants' arguments, the Examiner states in the Final Office Action mailed February 12, 2001, that the claim language does not require the indicia of payment authorizing delivery to be produced in human readable form, page 2, paragraph 3. Even if this assertion were accurate, however, the proffered combination cannot be read to meet the claims.

The above identified language of claim 57 requires that "said reproducing circuit also produces an indicia of payment authorizing delivery of said human readable information to said selected location." Accordingly, any indicia of *Kunigami* meeting the claims must authorize delivery of the reproduced human readable information.

The Examiner asserts that "the term 'human readable information' is not clearly defined, and can be interpreted as an electronic mail being displayed on a monitor, which is information readable by a human, as taught by *Kunigami*," Final Office Action mailed February 12, 2001 at page 2, lines 15-17. *Kunigami* teaches of a reproducing circuit which produces an indicia of payment authorizing delivery of the human readable information to the selected location (see Fig. 4A, "Fee Payer Identifier" being an "O" or a "D", column, 3, line 57 through column 4, line 25). Assuming, *arguendo*, that this assertion may be properly maintained, the indicia must authorize delivery of such human readable information. That is, not only must the electronic mail center (the intermediate station) of *Kunigami* reproduce the information as an electronic mail being displayed on a monitor, but so too must *Kunigami* provide an indicia of payment authorizing delivery of the monitor having the electronic mail displayed thereon (i.e., "an indicia of payment authorizing delivery of said human readable information to said selected location").

It simply cannot be said that there is any hint or suggestion provided within the disclosure of *Kunigami* for the delivery of an electronic mail being displayed on a monitor. Moreover, *Kunigami* does not even provide any hint or suggestion of the display of an electronic mail on a monitor, as relied upon as the foundation for the Examiner's rejection of this aspect of the claims.

Instead, *Kunigami* teaches only that the electronic mail message is stored in storage unit 11 of electronic mail center 2 (intermediate location), column 5, lines 62-63. Thereafter, electronic mail center 2 sends a message indicating that the receiver has mail received by the

electronic mail center, column 6, lines 3-6. Finally, the mail receiver may select the mail to be delivered to him and have the electronic mail displayed upon the receiver's terminal (selected location), column 6, lines 38-40. In addition to the disclosure of *Kunigami* being completely silent with respect to display of an electronic mail on a monitor of the electronic mail system, *Kunigami* does not teach a monitor being available for such a purpose at the electronic mail center, see e.g., Fig. 2.

Accordingly, even if one of ordinary skill in the art were to modify the system disclosed in *Albal* to include the aspect of *Kunigami* identified by the Examiner, the present invention would not result. Specifically, the resulting combination would not provide an intermediate station comprising a reproducing circuit adapted to reproduce information in human readable form, wherein the reproducing circuit also produces an indicia of payment authorizing delivery of the human readable information to the selected location. The claimed combination would require further unsuggested modifications to the combination relied upon by the Examiner.

In addition to the above identified differences between the applied art and the present claims, it is respectfully asserted that the fee payer identifier of *Kunigami* does not teach or suggest an indicia of payment authorizing delivery of the human readable information as recited in the claims. Directing the Board's attention to column 6, lines 38-45, of *Kunigami*, it is expressly taught therein that the receiver selects the mail to be delivered to him by entering a command to receive selected electronic mail and that the electronic mail center only transmits the electronic mail designated by the command. Accordingly, although the fee payer identifier may provide information with respect to who ultimately will pay for electronic mail for which the receiver authorizes delivery, it cannot be said that the fee payer identifier authorizes delivery of the electronic mail.

In response to Appellants' stated position, the Examiner asserts that "*Kunigami* teaches that the mail receiver views the 'Fee Payer Identifier', as seen in Fig. 4A, wherein when the identifier is an 'O', representing that the mail is paid for by the sender, the mail is authorized for delivery to the recipient, and when the identifier is a 'D', representing that the recipient is to pay the transmission charge, meaning that the sender did not pay, the mail is not authorized," Final Office Action mailed February 12, 2001, at page 3, lines 5-9. The Examiner opines that "[b]ecause of this, the *Kunigami* can be interpreted as producing 'an

indicia of payment authorizing delivery of said human readable information to said selected location', as required by the claim," Final Office Action at page 3, lines 9-11.

The Examiner's position appears to be that electronic mail having a Fee Payer Identifier of "D" is not authorized for delivery using the electronic mail system of *Kunigami*. However, this is not the case. *Kunigami* expressly provides for the authorized delivery of electronic mail having a Fee Payer Identifier of "D". For example, at column 8, lines 3-8, of *Kunigami*, it is taught that the fee for delivery may be optionally charged to the sender or the receiver. At column 5, lines 30-36, of *Kunigami* it is taught that if the sender sends the electronic mail and specifies the receiver as the fee payer, then the mail reception fee is borne by the receiver, or the receiver can reject the reception of the electronic mail.

Clearly, whether the Fee Payer Identifier is designated as an "O" for the fee to be borne by the originator or a "D" for the fee to be borne by the destination, all such electronic mail is available for authorized delivery according to *Kunigami*. Accordingly, it is respectfully asserted that the Fee Payer Identifier of *Kunigami* does not meet the "indicia of payment authorizing delivery" recited in the claims.

Proper Motivation To Combine The Prior Art References Has Not Been Provided

It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. In opining that it would have been obvious for one of ordinary skill in the art to have performed the modification of *Albal* in view of *Kunigami* proffered by the Examiner, the Examiner asserts that "*Albal*'s system would become more efficient and more automated if modified to incorporate *Kunigami*'s teachings, as the sender or receiver would be responsible for payment, wherein the intermediate station informs the receiver if the payment is performed by the sender," Final Office Action mailed February 12, 2001 at page 9, lines 6-9.

The language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Therefore, Appellants respectfully assert that the language relied upon as motivation for making the proffered combination is merely a statement that the reference can be modified, and does not state any desirability for making the modification.

In response to Appellants' position, the Examiner asserts that "the motivation for combining *Kunigami*'s teachings in *Albal*'s system is that *Albal*'s system would become more efficient, as the intermediate station informs the receiver if the payment is performed by the sender, therein allowing the recipient to choose any desired mail, thus preventing unwanted, or unpaid mail from being sent or stored at the receiver," Final Office Action at page 3, line 19, through page 4, line 2. However, the proffered efficiency is nothing more than the fee payor indicators of *Kunigami* allowing a receiver of an electronic mail message in a modified system of *Albal* to choose desired mail based upon the fee payor identifiers of *Kunigami*. That is to say, the stated motivation for combining *Kunigami* with *Albal* is to provide *Albal* with fee payor indicators of *Kunigami*. Such motivation is merely a statement that the reference can be modified, without providing any desirability for making the modification except for the result of the modification itself.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Moreover, it is respectfully asserted that modification of *Albal* to include the fee payer indicators of *Kunigami* allowing a receiver of an electronic mail message to prevent unwanted mail from being sent would not result in efficient operation of the system of *Albal*. Specifically, *Albal* teaches a ubiquitous payload delivery system to ensure that the payload is delivered to the recipient, column 2, lines 6-19. Accordingly, *Albal* sets forth primary methods of delivery for a message as well as backup methods of delivery to ensure receipt of the message by the recipient, column 8, lines 34-41.

If *Albal* were modified to include the fee payor indicators of *Kunigami* to allow a recipient to prevent mail from being delivered by one method, *Albal* would operate to attempt to deliver the mail by a secondary backup method, a tertiary backup method, and so on. Clearly, such a system would not result in the efficiency proffered by the Examiner.

In providing motivation for the proffered combination of *Albal* and *Berkowitz*, the Examiner asserts that "*Albal*'s system would become more versatile with the addition of

Berkowitz's converter circuit, as more user's would be able to send information electronically, wherein the user's do not have electronic mail capabilities or facsimile machines," Final Office Action mailed February 12, 2001 at page 9, lines 19-21.

Appellants assert that the statement of motivation is circular and, therefore, a mere statement that the reference can be modified. Accordingly, it is respectfully asserted that a *prima facie* case of obviousness has not been established with respect to the proffered combination of *Albal* in view of *Kunigami* and in further view of *Berkowitz*.

In response to Appellants' position, the Examiner asserts that "the motivation for combining *Berkowitz*'s teachings in *Albal*'s system is that *Albal*'s system would become more versatile, as more user's would be capable of using the system," Final Office Action at page 4, lines 10-12. However, the proffered versatility is nothing more than the multiple protocols set forth in *Berkowitz* allowing an electronic mail center in a modified system of *Albal* to accept mail and convert it to an electronic format using a scanner of *Berkowitz*. That is to say, the stated motivation for combining *Berkowitz* with *Albal* is to make the system of *Albal* generally better by including the attributes of *Berkowitz* now perceived to be better, without providing any desirability for making the modification except for the result of the modification itself.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Conclusion

As shown above, various aspects of the references relied upon in meeting independent claim 57 do not meet the claim limitations. Moreover, none of the references provide disclosure sufficient to cure the identified deficiencies in the proffered combinations. Additionally, proper motivation for combining the references has not been established. Therefore, Appellants respectfully assert that a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with respect to claim 57 or the claims dependent therefrom.

GROUP II – CLAIM 68

In addition to the limitations of independent claim 57 and intervening dependent claims 65 and 66, from which claim 68 depends, claim 68 recites:

wherein said funding means includes at least a value data packet.

It is important to note that, when read with the limitations of the claims from which claim 68 depends, the above value data packet is a part of ancillary information included with the transmitted information.

The Examiner concedes that the combination of *Albal* in view of *Kunigami*, in further view of *Berkowitz*, does not teach a funding means which includes a value data packet. However, in rejecting claim 68, the Examiner asserts that *Maxwell* teaches a funding means which includes at least a value data packet.

A review of *Maxwell* reveals that the disclosure teaches that message validator 22 accesses sender database 1300 to locate an account record for the sender, both of which are a part of the netgram workstation which is remotely coupled to the sender (transmission station) through the Internet, see column 4, lines 20-23 and 43-48, column 5, lines 12-17, and column 13, lines 19-31. It is this netgram workstation which is asserted by the Examiner to provide structure equivalent to the intermediate station recited in the claims. Accordingly, *Maxwell* cannot be fairly read to teach or suggest the transmission of ancillary information including a value data packet for funding the delivery of the information which is transmitted from transmission location.

In response to Appellants' previously submitted arguments, the Examiner asserts that *Albal* teaches transmission of ancillary information including a means for funding delivery of the transmitted information and that *Maxwell* is being relied upon to teach transmission of a value data packet. The Examiner, therefore, concludes that it would have been obvious to include the value data packet of *Maxwell* in the ancillary information of *Albal* to arrive at the present claim.

It is respectfully asserted that the invention of claim 68 would not have been obvious to have transmitted a value data packet from the transmission location to the intermediate location from the disclosures of *Albal* and *Maxwell*. Initially, it is pointed out that *Maxwell*

does not teach transmission of a value data packet. Instead, *Maxwell* teaches searching a sender database to determine if a sender's account record indicates prepayment sufficient to transmit the netgram, see column 9, lines 6-27. Each time the system of *Maxwell* prints a message the sender's account is decremented, see column 13, 28-31. There is no hint or suggestion of transmitting a value data packet whether from a sender's location, as recited in the claim, or an intermediate location.

Moreover, assuming arguendo that *Maxwell* suggested transmission of a value data packet, modification of *Albal* to include transmission of a value data packet would not have been obvious to one of ordinary skill in the art. *Albal* merely teaches that the sender is usually the one to bear the transmission costs and, therefore, is the one in the best position to set delivery parameters, see column 8, line 66, through column 9, line 3. There is no hint or suggestion of transmission of payment or funding information from a sending location provided by *Albal*. Accordingly, it is respectfully asserted that one of ordinary skill in the art would not have found it obvious to modify *Albal* in view of *Maxwell* to include transmission of a value data packet without the knowledge gleaned from Appellants' application.

As shown above, various aspects of the references relied upon in meeting dependent claim 68 do not meet the claim limitations. Moreover, none of the references provide disclosure sufficient to cure the identified deficiencies in the proffered combinations. Therefore, Appellants respectfully assert that a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with respect to claim 68 or the claim dependent therefrom. As such, the claim of Group II is asserted to be independently patentable with respect to the claims of all other claim groups herein.

GROUP III – CLAIM 69

In addition to the limitations of independent claim 57 and intervening dependent claims 65, 66, and 68, from which claim 69 depends, claim 69 recites:

said value is deducted from a credit stored at said transmitting location.

Accordingly, not only does claim 69 require that the value data packet be transmitted from the transmitting location, but claim 69 requires that the value be deducted from a credit stored at the transmitting location.

In rejecting claim 69, the Examiner asserts that *Maxwell* teaches of a funding means which includes at least a value data packet. A review of *Maxwell* reveals that the disclosure teaches that message validator 22 accesses sender database 1300 to locate an account record for the sender, both of which are a part of the netgram workstation which is remotely coupled to the sender (transmission station) through the Internet, see column 4, lines 20-23 and 43-48, column 5, lines 12-17, and column 13, lines 19-31. It is this netgram workstation which is asserted to provide structure equivalent to the intermediate station recited in the claims. Accordingly, *Maxwell* cannot be fairly read to teach or suggest the transmission or deduction of value from the transmission location.

In response to Appellants' previously asserted arguments with respect to *Maxwell* not teaching transmission of a value data packet from a transmitting location as recited in the claims, the Examiner asserts that the combination of *Albal*, *Kunigami*, *Berkowitz*, and *Maxwell* teach of ancillary information including a value data packet transmitted from the transmitting location. However, as shown above, *Maxwell* does not provide disclosure addressing this aspect of the claim.

Moreover, *Albal* merely teaches that the sender is usually the one to bear the transmission costs and, therefore, is the one in the best position to set delivery parameters, see column 8, line 66, through column 9, line 3. There is no hint or suggestion of transmission of payment or funding information from a transmitting location provided by *Albal*.

Kunigami teaches the preparation of billing information after transmission of the electronic mail based upon the transmission times of the various legs of electronic mail transmission, see e.g., column 7, lines 25-33. The billing information of *Kunigami*, based upon *a priori* information with respect to the actual transmission times associated with the electronic mail, simply cannot be read to meet the recited transmission of a value data packet from the transmitting station as recited in the claim.

Berkowitz teaches an automatic call director (ACD) system wherein calls and call information are transferred from a phone system such as a private branch exchange (PBX) to company agents, see e.g., column 3, lines 32-51. There is no hint or suggestion of transmission of value data packets therein.

As shown above, none of *Albal*, *Kunigami*, *Berkowitz*, or *Maxwell* provide any disclosure from which one of ordinary skill in the art would have been led to the transmission of a value data packet from a transmitting location as recited in the claim. Moreover, the proffered combination does not meet the recited aspect of deducting such a value from a credit store stored at the transmitting location.

The Examiner relies upon the disclosure of *Kunigami* to teach a value deducted from a credit stored at the transmitting location. However, *Kunigami* teaches the preparation of billing information after transmission of the electronic mail based upon the transmission times of the various legs of electronic mail transmission, see e.g., column 7, lines 25-33. In contrast, claim 69 recites value deducted from a credit stored at the transmitting location is communicated as a value data packet included ancillary to the transmitted information. The billing information of *Kunigami*, based upon *a priori* information with respect to the actual transmission times associated with the electronic mail, simply cannot be altered to meet the present claim without unacceptably changing the principle of operation of the prior art invention being modified, M.P.E.P. § 2143.01 citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959).

As shown above, various aspects of the references relied upon in meeting dependent claim 69 do not meet the claim limitations. Moreover, none of the references provide disclosure sufficient to cure the identified deficiencies in the proffered combinations. Therefore, Appellants respectfully assert that a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with respect to claim 69. As such, the claims of Group III is asserted to be independently with respect to the claims of all other claim groups herein.

GROUP IV – CLAIM 72

In addition to the limitations of independent claim 57 and intervening dependent claim 65, from which claim 72 depends, claim 72 recites:

said ancillary information includes a time of transmission of said document by said transmitting means, said time being provided by a secure time piece disposed at said transmitting location.

Accordingly, claim 72 recites ancillary information included with the transmitted information, wherein the ancillary information includes a time of transmission of the

document which is provided by a secure time piece disposed at the transmitting location. The mention of delivery parameters including the time for delayed delivery provided in *Albal* at column 9, lines 1-3, and relied upon by the Examiner in rejecting claim 72, does not meet the requirement that the time of transmission is transmitted with the document from the transmitting location.

In responding to the Appellants' argument that *Albal* does not teach transmission of time of transmission with a document transmitted from a transmitting location, the Examiner asserts that the claim does not require transmission of the time information with a document as base claim 57 and intervening claim 65 do not recite a document, Final Office Action mailed February 12, 2001 at page 4, lines 19-21. However, claim 72 clearly and unequivocably recites that the ancillary information included with the transmitted information includes a time of transmission of the document. Accordingly, in order for the rejection of record to be properly maintained, *Albal* must, *inter alia*, teach or suggest transmission of time of transmission information with a document.

If it is the Examiner's position that recitation of information in claims 57 and 65 and recitation of document in claim 72 is unclear or indefinite, it is respectfully asserted that the Examiner should apply a 35 U.S.C. § 112 rejection rather than the 35 U.S.C. § 103 rejection of record, see M.P.E.P. § 2143.03. Although Appellants believe the claim as written meets the requirements of 35 U.S.C. § 112, Appellants would be agreeable to amending the language of claim 72 to more closely track the language of claims 57 and 65 in response to a rejection under 35 U.S.C. § 112. However, as the Examiner has never provided such a rejection of record in the 6 Office Actions of record, it is presumed the Examiner is in agreement with the Appellants that the language of claim 72 is proper under 35 U.S.C. § 112.

Additionally, the identified portion of *Albal* does not fairly teach or suggest the use of a secure time piece. Although the Examiner asserts that the use of a secure time piece is inherent, such a bald assertion is insufficient to establish a proper rejection under either 35 U.S.C. § 102 or 35 U.S.C. § 103. In order to properly establish a rejection based on inherency, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," M.P.E.P. § 2112, citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original). A reference may

not be anticipating under the principle of inherency on the basis of possibilities or probabilities, as anticipation by inherency requires that persons skilled in the art would recognize that the missing material is “necessarily present” in the reference, see *In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

The Examiner’s statement that a secured time piece would inherently be used by a workstation does not reasonably support a conclusion that the claimed secure time piece for providing a time of transmission of the document necessarily flows from the disclosure of the prior art. Workstations typically are provided with a non-secure real time clock. Moreover, there is no indication in *Albal* that the time for delayed delivery is in any way information which should be provided by a secure device. Accordingly, Appellants respectfully assert that the claim is allowable under 35 U.S.C. § 103 over the art of record.

In response to the Appellants’ previous arguments, the Examiner asserts that a time piece which would inherently be in the computer is secure within the computer and, therefore, is a secure time piece, Final Office Action mailed February 12, 2001 at page 5, lines 9-11. It is respectfully asserted that such a reading of the claim limitation does not properly give weight to the recitation of “secure.” Following the Examiner’s reasoning, any component provided in any system would meet a secure limitation of a claim. This would render the “secure” language superfluous which is improper when the claim is interpreted in light of the specification, see e.g., page 7, line 25, through page 8, line 6, of the present specification, see also *In re Van Geuns*, 26 U.S.P.Q.2d 1057 (Fed. Cir. 1993).

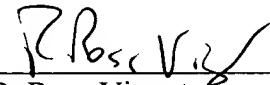
As shown above, various aspects of the references relied upon in meeting dependent claim 72 do not meet the claim limitations. Moreover, none of the references provide disclosure sufficient to cure the identified deficiencies in the proffered combinations. Therefore, Appellants respectfully assert that a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with respect to claim 72. As such, the claim of Group IV is asserted to be independently patentable with respect to the claims of all other claim groups herein.

SUMMARY

As shown above, the Examiner has not properly established a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to the pending claims. Accordingly,

Appellants respectfully submit that claims 57-74 and 90 are patentable over the applied art. Therefore, reversal of the rejections of record is courteously solicited.

Respectfully submitted,



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**Appendix A****Claims on Appeal**

The text of the claims involved in the appeal are:

57. A system for delivering information to a selected location from a transmitting location, said system comprising:

a transmission station operable at said transmitting location and adapted to transmit said information to an intermediate location; and

an intermediate station operable at said intermediate location and adapted to receive said information transmitted by said transmitting station, wherein said intermediate station comprises:

a converter circuit adapted to electronically receive said transmitted information and to convert said transmission to electronic form if said transmitted information is not initially in electronic form; and

a reproducing circuit adapted to reproduce said information in human readable form, wherein said reproducing circuit also produces an indicia of payment authorizing delivery of said human readable information to said selected location.

58. The system of claim 57, wherein said intermediate location is selected according to proximity to said selected location.

59. The system of claim 58, wherein said intermediate location selection is accomplished automatically by said transmitting location through reference to address information with respect to said selected location.

60. The system of claim 57, wherein said intermediate location is selected according to proximity to said transmitting location.

61. The system of claim 57, wherein said converter circuit comprises:
circuitry adapted to accept electronic documents communicated utilizing different communication protocols.

62. The method of claim 61, wherein said different communication protocols include at least two protocols selected from the group consisting of:

a standardized electronic mail protocol;
a special purpose mail communication protocol;
a standardized facsimile protocol;
a standardized character based protocol; and
a standardized packet based protocol.

63. The system of claim 57, wherein said converter circuit further comprises:
circuitry adapted to determine delivery address information with respect to said selected location from information contained within said transmitted information.

64. The system of claim 63, wherein said converter circuit further comprises:
circuitry adapted to verify the accuracy of said delivery address information.

65. The system of claim 57, further comprising:

means for including ancillary information with said transmitted information, said ancillary information being suitable for use by said [receiving means] intermediate station in delivery of said transmitted information to said selected location.

66. The system of claim 65, wherein said ancillary information comprises:

means for funding the delivery of said transmitted information.

67. The system of claim 66, wherein said intermediate station further comprises:

an acknowledgment circuit adapted to produce an acknowledgment of receipt of said transmitted information; and

wherein said acknowledgment circuitry is further adapted to transmit said acknowledgment to said transmitting location, wherein said last mentioned portion of the acknowledgment circuit is inactive until said funding means is confirmed.

68. The system of claim 66, wherein said funding means includes at least a value data packet.

69. The system of claim 68, wherein said value is deducted from a credit stored at said transmitting location.

70. The system of claim 65, wherein said ancillary information includes a delivery address of said selected location.

71. The system of claim 70, wherein said converter circuit further comprises:

means for verifying the accuracy of said delivery address information.

72. The system of claim 65, wherein said ancillary information includes a time of transmission of said document by said transmitting means, said time being provided by a secure time piece disposed at said transmitting location.

73. The system of claim 65, wherein said ancillary information includes specific delivery information regarding the delivery of said human readable information, indicating selection of at least one delivery option of a plurality of delivery options available for delivery of said transmitted information.

74. The system of claim 57, wherein said reproducing circuit is operable at least in part with corresponding circuitry disposed at said selected location.

90. The system of claim 57, wherein said intermediate station further comprises:
an acknowledgment circuit adapted to produce an acknowledgment of receipt of said transmitted information.